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1                    RECORD OF ORAL HEARING

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3       UNITED STATES PATENT AND TRADEMARK OFFICE

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6          BEFORE THE BOARD OF PATENT APPEALS

7               AND INTERFERENCES

8                    ———————

9

10       *Ex parte* TONI PAILA, JANI PAIKELA, LIN XU,

11         JUHA-PEKKA LUOMA, and ROD WALSH

12                    ———————

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14              Appeal 2009-012730

15              Application 09/988,241

16             Technology Center 2600

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18                  ———————

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20         Oral Hearing Held:  July 21, 2010

21                  ———————

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23  Before JOHN C. MARTIN, JOSEPH F. RUGGIERO and

24  CARLA M. KRIVAK, *Administrative Patent Judges.*

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27  APPEARANCES:

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30  ON BEHALF OF THE APPELLANT:

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1        The above-entitled matter came on for hearing on Wednesday, July

2  21, 2010, commencing at 10:17 a.m., at the U.S. Patent and Trademark

3  Office, 600 Dulany Street, Alexandria, Virginia, before Paula Lowery,

4  Notary Public.

5  THE CLERK:  Good morning.  Calendar Number 31, Appeal No. 2009-

6  012730, Mr. Dannenberg.

7  JUDGE MARTIN:  Good morning, Mr. Dannenberg.

8  MR. DANNENBERG:  Good morning, Your Honors.

9  JUDGE MARTIN:  You can proceed whenever you're ready.

10  Perhaps I should tell you right up front my problems with this case are

11  whether we should be looking at the provisional application at all, or

12  whether this argument about the 131 declaration is belated and not entitled

13  to consideration at this time.

14  MR. DANNENBERG:  I actually did consider that, Your Honor, and would

15  like to point out in clarification that the evidence appendix we submitted

16  with our Reply Brief, it's not actually new evidence in this case.   That

17  evidence appendix perhaps was mischaracterized as new evidence, but that

18  131 declaration was actually made in response to a previous office action

19  and has been in the record of this case.

20  So in response to one of the earlier office actions, the Examiner cited a

21  reference -- the name I forget -- in response to which we did file two 131

22  declarations.  The second of which is the one that established our filing date

23  of August 20, 2001.

24  In response to that, the Examiner withdrew the rejections and made a new a

25  rejection to the claims in this case, apparently accepting the 131

1   declarations.  So the claims have not changed since that 131 declaration was

2   filed.  It's the same claims at issue.

3   JUDGE MARTIN:  Let me interrupt a second to get the timeline straight.  It

4   seems to me, if I've got the record correct, that the Examiner found the

5   second 131 declaration effective to overcome Chin.  That determination was

6   made in an action mailed in June of '05.

7   We have a number of years go by where there's been rejections based on

8   Leung, and even in the Brief there was no reliance on the 131 declarations;

9   and now we see the argument in the Reply Brief that that same declaration

10   gets around the Leung printed patent application.

11   That's four years.  So this kind of just slipped through the cracks, right?

12   MR. DANNENBERG:  I understand, and maybe so that argument did; but at

13   the same time, we were under the understanding that when the Examiner

14   accepted that 131 declaration that that moves the effective filing date --

15   effective priority date, excuse me -- to August 20, 2001; and he would be

16   searching only for references that antedate that date.

17   JUDGE MARTIN:  Right, but this point you're making now was just made

18   in the Reply Brief?

19   MR. DANNENBERG:  That is correct.

20   JUDGE MARTIN:  It's a new argument.  The Examiner hasn't considered

21   the provisional Leung, right?  To see whether it provides support for those

22   paragraphs that you had argued about?  We don't know what the Examiner's

23   position is on that position, right?

24   MR. DANNENBERG:  We don't know what the Examiner's position is on

25   that point, but we do know that the Examiner is aware of our priority date is

1  August 20, 2001, because it's the same Examiner that's considered the 131

2  declarations and found them effective to overcome Chin.

3  JUDGE MARTIN:  In your Reply Brief you said the Examiner made a new

4  ground of rejection, and you thought that maybe -- is that the reason why

5  you think you can bring up this argument now?

6  MR. DANNENBERG:  One of the bases.  We're relying on new areas of the

7  reference.

8  Your Honor, to be honest, it slipped through the cracks that we didn't catch

9  the filing date; but I would ask that you also look at the fact that this case has

10  been pending nine years at this point.

11  We filed our Appeal almost four years ago, August 12th, I think, 2006.  So

12  we're looking for some resolution on this case.

13  Yes, it will turn on whether that declaration is accepted or not, so if I may

14  proceed with some of the arguments, assuming that the declaration is

15  accepted.  I understand your position that that is a critical issue.

16  JUDGE MARTIN:  Before you proceed, is your argument that we should

17  look at the effect of the declaration now -- does that hinge on whether or not

18  the Examiner made a new ground of rejection in the answer?

19  MR. DANNENBERG:  No, I don't believe it does.

20  JUDGE MARTIN:  Okay.

21  MR. DANNENBERG:  I believe the declaration was made of record early in

22  the prosecution of this case.  It's just a fact in this case.  That the effective

23  priority date is August 20, 2001.

24  The Examiner was aware of that by reviewing and accepting the declaration

25  back when he did, and even citing the Chin reference.  He had to have seen

1    its filing date and had to have seen that it was supported by a provisional in

2    order to rely on it in the first place.

3    So he, himself, must have been aware that only whatever is provisional is

4    applicable in the Leung reference.  That's our position on the declaration.

5    JUDGE MARTIN:  All right.

6    MR. DANNENBERG:  If I may proceed then?

7    JUDGE MARTIN:  Sure.

8    MR. DANNENBERG:  It sounds like you've read the history, but I'll

9    summarize the technology here.

10   We're talking about multicast session announcements in mobile

11   broadcasting.  An example -- nonlimiting example -- would be if you have a

12   mobile phone that can receive radio or a mobile phone that can receive

13   television.  Receiving a one-way multicast communication.

14   When the phone is communicating in the cell, it receives an overhead

15   announcement that says, okay, if you want to listen to channel 1, these are

16   your parameters.  If you want to listen to channel 2, use these parameters.

17   So the invention here is when the cell or when the mobile device is in cell

18   number 1 it receives that overhead announcement, which includes

19   parameters not only for cell number 1, but also includes parameters for cell

20   number 2.

21   Back when this was filed, you know, our effective priority date, August,

22   2001, this was novel.  Keep in mind we're dealing with a novelty rejection

23   not an obviousness rejection.

24   So the Leung provisional application that we're dealing with as the only

25   piece of prior art in front of us does not describe multicast session

1   information for neighboring cells.  It only describes, at best, the identity of a

2   base station of a neighboring cell.

3   I should give credit, one of our summer associates came up with the

4   argument.  It's akin to our application says, you know, we need you to drive

5   to Richmond and here is a map of how to get to Richmond.  Whereas the

6   Leung provisional is equivalent to saying, here's a 7-11 where you can buy a

7   map.  Go figure it out.

8   So the multicast session information is information sufficient to tune to the

9   broadcast channels in the cells, which is not disclosed in the Leung

10  provisional application.

11  In addition, I'd like to point out that while albeit we did not include them

12  under separate headers, we do maintain the position that we argued in

13  Claims 2, 9, and 34 separately.  That we made additional arguments in the

14  Appeal Brief regarding the additional limitations in those claims.

15  So Claim 1 is definitely our broadest claim.  You know, Leung does not

16  describe this multicast session information in multiple cells.  Again, it only

17  describes the identity of a base station in a second cell.

18  So even if that were to be considered multicast session information, if you

19  look, for example, with respect to Claim 2, Claim 2 requires that the

20  multicast session information comprises a session identifier and a list of cells

21  in which the multicast session is available, which is the lone provisional.

22  We found no evidence of that.

23  For example, with respect to Claim 9, we further state that the multicast

24  session information comprises link level access parameters corresponding to

25  first cells and second cells.  The identity of a base station is not link level

26  access

1    parameters -- parameters is plural.  There are multiple parameters we are

2    dealing with.

3    Finally, with respect to Claim 34, another independent claim, we actually go

4    so far as to say the information that maps link level access parameters in

5    each of the plurality of cells to the multicast session.

6    So here it even requires mapping of link level access parameters to the

7    session with multiple cells.

8    So all these features, even if Leung is interpreted as the identity of a base

9    station being multicast session information, it still does not teach or suggest -

10   - even though this is an anticipation rejection -- it does not teach or suggest

11   that multicast session information comprises a session identifier and a list of

12   cells as in Claim 2.  It does not map link level access parameters to each of a

13   plurality of cells to the multicast session as recited in Claim 34.

14   I skipped over Claim 9. The multicast session information does not describe

15   multicast session information comprising link level access parameters

16   corresponding to the first and second cells.

17   Those are the primary points I wanted to make here today.  If you have

18   questions, I will gladly answer them.

19   JUDGE MARTIN:  Questions?

20   JUDGE RUGGIERO:  No questions.

21   JUDGE KRIVAK:  No.

22   JUDGE MARTIN:  No further questions, thank you.

23        Whereupon, the proceedings at 10:27 a.m. were concluded.

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